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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
HOFFMAN, BRANDON S	
ART UNIT	**PAPER NUMBER**
2136	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/685,026	MARTINS ET AL.	
	Examiner	Art Unit	
	Brandon Hoffman	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Rejections

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 1, 3-6, 24, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urata (U.S. Patent No. 6,799,272) in view of Kawan (U.S. Patent No. 6,289,324).

Regarding claims 1 and 27, Urata teaches a method/computer readable medium for preventing counterfeiting and cloning of smart cards, comprising:

- Providing a smart card with a cryptographic structure for authorizing the smart card which cannot be accessed completely by a predetermined small number of readings (col. 2, lines 32-52).

Urata does not teach wherein said cryptographic structure can be built only by whoever emits the card or an agent thereof.

Kawan teaches wherein said cryptographic structure can be built only by whoever emits the card or an agent thereof (col. 9, lines 36-43).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine wherein said cryptographic structure can be built only by whoever emits the card or an agent thereof, as taught by Kawan, with the method of Urata. It would have been obvious for such modifications because keeping the cryptographic structure secret to only those who emit the card prevents someone from counterfeiting a smart card (see col. 9, lines 36-40 of Kawan).

Regarding claim 24, Urata teaches a method of preventing counterfeiting of a smart card, comprising:

- Providing a smart card such that none of confidential information and a cryptographic key for authorizing the smart card, is carried on the smart card (col. 2, lines 32-52);
- Reading said card by a reader such that in each reading, said reader reads only a predetermined small amount of information which makes the card unique (col. 2, lines 32-52).

Urata does not specifically teach a reader for the smart card, but an authentication center that receives the data over a communication system.

Kawan teaches a reader for the smart card (fig. 2, ref. num 210).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a smart card reader, as taught by Kawan, with the method of Urata. It would have been obvious for such modifications because a smart card reader provides the interfacing means for accessing the information on the smart card.

Regarding claims 3 and 25, the combination of Urata as modified by Kawan teaches wherein an entire process of said method is performable off-line (see col. 5, lines 47–59 of Kawan).

Regarding claim 4, the combination of Urata as modified by Kawan teaches wherein said smart card carries thereon predetermined N channels as C1, C2, ..., CN, where N is an integer, wherein each channel Ci, with i equal to 1, 2, ..., N, carries a pair of numbers (hi, li), and wherein hi is the i^{th} high number and li is the i^{th} low number (see col. 2, lines 32-52 and fig. 1, ref. num 106, 128, and 142 of Urata).

Regarding claim 5, the combination of Urata as modified by Kawan teaches further comprising using public key cryptography with associated encoding and decoding functions Vi and Vi^{-1} in each channel i, wherein each function Vi^{-1} is known publicly, and Vi is known only to a predetermined party representing an owner of the smart card (see page 6, lines 1-5 of applicants disclosure, applicant submits this information is well known as taught by Menezes et al.).

Regarding claim 6, the combination of Urata as modified by Kawan teaches wherein for each i in 1, 2, ..., N, the pair (hi, li) is such that hi = Vi(li), or hi = Vi(K(li)), where K represents a publicly-known cryptographic hash function, and wherein each li contains a plurality of symbols for redundancy (see page 6, lines 6-8 of applicants disclosure, applicant submits this information is well known as taught by Menezes et al.).

Regarding claim 7, the combination of Urata as modified by Kawan teaches further comprising processing, using an invertible function f which is made public, such that the low numbers in said smart card satisfy $l(i+j) = f^j(li)$, where f^j represents the j^{th} iteration of the function f (see col. 5, line 48 through col. 6, line 25 of Urata).

Regarding claim 9, the combination of Urata as modified by Kawan teaches wherein a reader obtains a content of only two of said channels (see col. 2, lines 37-47 of Urata).

Regarding claim 13, the combination of Urata as modified by Kawan teaches wherein said cryptographic structure is changed periodically (see col. 6, lines 33-42 of Urata).

Claims 8 and 15-18, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urata (USPN '272) in view of Kawan (USPN '324), and further in

view of Schneier, "Applied Cryptography: Protocols, Algorithms, and Source Code in C," Second Edition, pps. 466-474 (hereinafter Schneier).

Regarding claim 8, the combination of Urata as modified by Kawan teaches all the limitations of claims 1, 4, 5, and 6, above. However, the combination of Urata as modified by Kawan does not teach wherein a reader includes a random number generator, which, when a card is read, chooses a pair (a, b) of distinct numbers with a < b between 1 and N, wherein before processing the smart card, the reader obtains the pair (ha, la) and hb, and using the public keys Va^{-1} and Vb^{-1}, checking by the reader whether the pairs (ha, la) and (hb, lb) are compatible, and, consequently, that the numbers ha, la, and hb belong to a same legitimate card.

Schneier teaches:

- Wherein a reader includes a random number generator, which, when a card is read, chooses a pair (a, b) of distinct numbers with a < b between 1 and N, wherein before processing the smart card, the reader obtains the pair (ha, la) and hb (a step of an RSA algorithm, choose two prime numbers, page 467);
- Using the public keys Va^{-1} and Vb^{-1}, checking by the reader whether the pairs (ha, la) and (hb, lb) are compatible, and, consequently, that the numbers ha, la, and hb belong to a same legitimate card (a step of an RSA algorithm, page 467).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine generating a random number in the reader, choose a pair of distinct numbers, and using the public keys to check the compatibility of the smart card, as taught by Schneier, with the method of Urata/Kawan. It would have been obvious for such modifications because these limitations verify a proper smart card based on the key checking, known as a digital signature.

Regarding claim 15, the combination of Urata as modified by Kawan/Schneier teaches wherein said pairs (hi, li) to be contained on the smart card are generated by:

- Choosing a prefix of I1 once for all transactions, or changed whenever needed, wherein said prefix is publicly known (a step of an RSA algorithm, see page 467 of Schneier); and
- Providing a sequence, such that the sequence is generated so that a same number is not chosen twice, and so that corresponding other li's are not chosen as new I1s (a step of an RSA algorithm, see page 467 of Schneier).

Regarding claim 16, the combination of Urata as modified by Kawan/Schneier teaches further comprising:

- Concatenating the prefix and the sequence to form I1 (a step of an RSA algorithm, forming the product of two primes, see page 467 of Schneier); and

- Choosing a function f which is invertible and is publicly known, to construct I2 = f(I1), I3 f(I2), and so forth (a step of an RSA algorithm, use Euclidean algorithm on two primes, see page 467 of Schneier).

Regarding claim 17, the combination of Urata as modified by Kawan/Schneier teaches wherein the function f is chosen to be the identity map, in which case I1 = I2 = I3 = ... =IN (a step of an RSA algorithm, where the message is encrypted in blocks, where the same encryption method is used for each block, see page 467 of Schneier).

Regarding claim 18, the combination of Urata as modified by Kawan/Schneier teaches choosing, for a number N, N public key-private key pairs, such that a first private key V1 is for computing h1 = V1 (I1), a second private key V2 is for computing h2 = V2(I2), and so on (a step of an RSA algorithm, where the message is encrypted in blocks, see page 467 of Schneier).

Regarding claim 20, the combination of Urata as modified by Kawan teaches all the limitations of claim 1, above. However, the combination of Urata as modified by Kawan does not teach wherein, when the smart card is read by a reader, a random generator is prompted which provides two integer numbers, a and b, which are not between 1 and N, with a < b.

Schneier teaches wherein, when the smart card is read by a reader, a random generator is prompted which provides two integer numbers, a and b, which are not between 1 and N, with a < b (a step of an RSA algorithm, see page 467).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine generating a random number when the smart card is read, the random numbers are a and b, with a < b, as taught by Schneier, with the method of Urata/Kawan. It would have been obvious for such modifications because these limitations select a public key of the reader for use in a public key algorithm. The public key can then be used to encrypt data so that only the intended recipient can decrypt the data.

Regarding claim 21, the combination of Urata as modified by Kawan/Schneier teaches wherein said numbers a, b are transmitted to the smart card which delivers two high numbers ha, hb, and a low number la in a channel a, and wherein the pair (a, b), together with a function f in a memory in the reader, are used to compute the low number $lb=f^{(b-a)}(la)$, said memory in said reader delivering public keys Va^{-1} and Vb^{-1} (a step of an RSA algorithm, see page 467 of Schneier).

Regarding claim 22, the combination of Urata as modified by Kawan/Schneier teaches wherein the public keys are used by a comparator together with the pairs (ha, la) and (hb, lb), to verify that the pairs are compatible with the corresponding keys, and

that the pairs are from a same legitimate card (a step of an RSA algorithm, see page 467 of Schneier).

Claims 2, 10-12, 14, 23, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urata (USPN '272) in view of Kawan (USPN '324), and further in view of Perlman et al. (U.S. Patent No. 5,261,002).

Regarding claim 2, the combination of Urata as modified by Kawan teaches providing a reader for reading said smart card (see fig. 2, ref. num 210 of Kawan). However, the combination of Urata as modified by Kawan does not teach including a database holding information related to unauthorized smart cards, said reader being on-line, such that said reader is operatively connected to a network, only when said database of said reader is being updated by said network.

Perlman et al. teaches including a database holding information related to unauthorized smart cards, said reader being on-line, such that said reader is operatively connected to a network, only when said database of said reader is being updated by said network (col. 3, lines 38-40, col. 6, lines 37-39, and fig. 1, ref. num 24-30).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a reader including a database of unauthorized smart cards, said reader being online and connected to a network only when said reader is

being updated, as taught by Perlman et al., with the system of Urata/Kawan. It would have been obvious for such modifications because the off-line version of the blacklist provides a listing of all users who are intruders; the periodic updating allows a newer list of intruders to be known.

Regarding claim 10, the combination of Urata as modified by Kawan teaches all the limitations of claim 1, above. However, the combination of Urata as modified by Kawan does not teach further comprising periodically communicating, by a reader of said smart card, with a database where a predetermined characteristic of the card is checked.

Perlman et al. teaches further comprising periodically communicating, by a reader of said smart card, with a database where a predetermined characteristic of the card is checked (col. 3, lines 38-40 and fig. 1, ref. num 16-18).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine periodically communicating with a database where a predetermined characteristic of the card is checked, as taught by Perlman et al., with the method of Urata/Kawan. It would have been obvious for such modifications because the off-line version of the blacklist provides a listing of all users who are intruders; the periodic updating allows a newer list of intruder to be known.

Regarding claim 11, the combination of Urata as modified by Kawan/Perlman et al. teaches wherein the predetermined characteristic comprises whether a smart card has delivered more than a predetermined amount of money to a user of the smart card (see col. 7, lines 21-23 of Perlman et al.).

Regarding claim 12, the combination of Urata as modified by Kawan/Perlman et al. teaches wherein if a card is detected as delivering too much money, the database communicates a corresponding number I1 to all readers in a network, so that smart cards carrying said corresponding number are declined (see col. 7, lines 14-26 of Perlman et al.).

Regarding claim 14, the combination of Urata as modified by Kawan teaches all the limitations of claim 1, above. However, the combination of Urata as modified by Kawan does not teach wherein said smartcard is invalidated after a predetermined time of usage.

Perlman et al. teaches wherein said smartcard is invalidated after a predetermined time of usage (fig. 2, ref. num 42).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine invalidating the smartcard after a predetermined time of usage, as taught by Perlman et al., with the method of Urata/Kawan. It would have

been obvious for such modifications because the time limit threshold provides more security by allowing only a certain time of use. This prevents someone from stealing the card and using it for any length of time.

Regarding claim 23, the combination of Urata as modified by Kawan teaches all the limitations of claim 1, above. However, the combination of Urata as modified by Kawan does not teach further comprising performing a final validation of the smart card by at least one of contacting a central database if an entire transaction is made on-line with no penalty; and checking with a local database in a reader, said local database being refreshed periodically by contact between said local database and said central database.

Perlman et al. teaches further comprising performing a final validation of the smart card by at least one of:

- Contacting a central database if an entire transaction is made on-line with no penalty (col. 6, lines 37-39); and
  Checking with a local database in a reader, said local database being refreshed periodically by contact between said local database and said central database (col. 3, lines 38-40 and fig. 1, ref. num 24-30).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the reader including a database for linking to a network

for periodic updates, as taught by Perlman et al., with the method of Urata/Kawan. It would have been obvious for such modifications because the off-line version of the blacklist provides a listing of all users who are intruders; the periodic updating allows a newer list of intruder to be known.

Regarding claim 26, Urata teaches a system for preventing cloning of a smart card, comprising:

- A smart card such that a cryptographic structure for authorizing the smart card is not carried on the smart card (col. 2, lines 32-52).

Urata does not teach a reader for reading the smart card and including a database for linking to a network and being updated periodically with a list of unauthorized smart cards, wherein said cryptographic structure is kept secret by whoever emits the card or an agent thereof,

Kawan teaches wherein said cryptographic structure is kept secret by whoever emits the card or an agent thereof (col. 9, lines 36-43).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine wherein said cryptographic structure can be built only by whoever emits the card or an agent thereof, as taught by Kawan, with the system of Urata. It would have been obvious for such modifications because keeping the

cryptographic structure secret to only those who emit the card prevents someone from counterfeiting a smart card (see col. 9, lines 36-40 of Kawan).

The combination of Urata as modified by Kawan still does not teach a reader for reading the smart card and including a database for linking to a network and being updated periodically with a list of unauthorized smart cards.

Perlman et al. teaches a reader for reading the smart card and including a database for linking to a network and being updated periodically with a list of unauthorized smart cards (col. 3, lines 38-40, col. 6, lines 37-39, and fig. 1, ref. num 24-30).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a reader for reading the smart card and including a database for linking to a network and being updated periodically with a list of unauthorized smart cards, as taught by Perlman et al., with the system of Urata/Kawan. It would have been obvious for such modifications because the off-line version of the blacklist provides a listing of all users who are intruders; the periodic updating allows a newer list of intruders to be known.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Urata (USPN '272) in view of Kawan (USPN '324), and Schneier, and further in view of Perlman et al. (USPN '002).

Regarding claim 19, the combination of Urata as modified by Kawan/Schneier teaches further comprising: verifying whether the smart card is authentic (digital signature of an RSA algorithm, see page 473 of Schneier).

The combination of Urata as modified by Kawan/Schneier does not teach checking whether the smart card is not in a list of cards to be refused.

Perlman et al. teaches checking whether the smart card is not in a list of cards to be refused (col. 6, lines 37-39).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine checking the list of smart cards to be refused, as taught by Perlman et al., with the method of Urata/Kawan/Schneier. It would have been obvious for such modifications because the limitations provide a listing of all users who are intruders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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